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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,359	06/06/2006	Shirou Sawa	2006_0587A	6815

EXAMINER	
BLAND, LAYLA D	

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1623	

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2033 K STREET N. W.
SUITE 800
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,359	Applicant(s) SAWA, SHIROU	
	Examiner Layla Bland	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/2006, 8/28/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is a national stage entry of International Application No. PCT/JP04/16849, filed November 12, 2004, which claims priority to Japanese Application No. 2003-384646, filed November 14, 2003. Claims 1-8 are pending in this application and are examined on the merits herein.

Information Disclosure Statement

Document JP 2683676 of the IDS submitted August 28, 2006 was not considered because it is not in English. Only the English abstracts and/or partial translations of the other Japanese documents of the IDS submitted May 5, 2006 and the IDS submitted August 28, 2006 were considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu et al. (US 5,414,011, May 9, 1995, PTO-1449 submitted May 5, 2006) in view of Cagle et al. (US 6,440,964, August 27, 2002).

Fu et al. teach an ophthalmic formulations wherein preferred embodiments comprise ketorolac (0.25-0.5% wt/vol.) and tobramycin (0.15-0.3% wt/vol.), as well as

buffers and nonionic surfactants [columns 9 and 10, Examples 3-6]. Other suitable NSAIDs include indomethacin, flurbiprofen sodium, and suprofen [column 6, lines 9-16]. The formulations are prepared by dissolving the solutes in water and adjusting the pH to about 6-8 [column 6, lines 63-67]. Suitable buffers include citrate [column 6, lines 48-50]. The ophthalmic formulations can be administered in the form of an eye drop [column 8, lines 24-35].

Fu et al. do not teach formulations comprising bromfenac.

Cagle et al. teach ophthalmic and otic formulations comprising an antibiotic and a non-steroidal anti-inflammatory agent. Cyclooxygenase type I and type II inhibitors such as diclofenac, flurbiprofen, ketorolac, suprofen, bromfenac, and indomethacin are preferred NSAIDs for use in the formulations. [column 7, lines 49-58]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare an aqueous composition comprising tobramycin and bromfenac. One of ordinary skill in the art could have substituted bromfenac for ketorolac, indomethacin, flurbiprofen, or suprofen in the formulation of Fu et al. and could have predicted the efficacy of such a formulation because these NSAIDs are all members of the same class of compounds and are described in the art as alternatives for the treatment of inflammation of ophthalmic tissues.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the Examiner concludes that the subject

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matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Bland whose telephone number is (571) 272-9572. The examiner can normally be reached on M-R 8:00AM-5:00PM UST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on (571) 272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Layla Bland
Patent Examiner
Art Unit 1623
November 13, 2007

Shaojia Anna Jiang


Supervisory Patent Examiner
Art Unit 1623
November 13, 2007